

## **REMARKS/ARGUMENTS**

Claims 124, 129-131 and 135-138 are pending and stand rejected in this application. The rejections to the presently pending claims are respectfully traversed.

### **Claim Rejections – 35 U.S.C. §101 and §112, First Paragraph**

Claims 124, 129-131 and 135-138 are rejected under 35 U.S.C. §101 allegedly “because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.”

Claims 124, 129-131 and 135-138 are further rejected under 35 U.S.C. §112, first paragraph, allegedly “since the claimed invention is not supported by either a credible, specific and substantial asserted utility or a well established utility, one skilled in the art clearly would not know how to use the claimed invention.”

The Examiner asserts throughout prosecution that the increase in PRO809 nucleic acid in the gene amplification assay is possibly due to aneuploidy. Applicants respectfully disagree.

### **Arguments**

Applicants maintain, for the reasons set forth in the previously filed Appeal Brief, that the specification discloses at least one credible, substantial and specific asserted utility for the claimed PRO809 nucleic acids. Applicants’ arguments presented in the previously filed Appeal Brief are incorporated herewith in their entirety. As discussed before, Applicants rely on the gene amplification data for patentable utility for the PRO809 nucleic acids and submit that the gene amplification data under Example 170, sufficiently discloses patentable utility for the PRO809 nucleic acids.

Accordingly, the present 35 U.S.C. §101 and §112, first paragraph, utility and enablement rejections should be withdrawn.

### **Claim Rejections - 35 U.S.C. §112, First Paragraph - Enablement**

Claims 124, 129-131 and 135-138 remain rejected under 35 U.S.C. 112, first paragraph, since the skilled artisan would require undue experimentation to make and use the claimed invention.

Applicants respectfully traverse and maintain their position that the instant specification provides an enabling disclosure, based on the reasons set forth above and in the Appeal brief and the Reply brief and hence, this rejection should be withdrawn.

**Claim Rejections – 35 U.S.C. §102(b)**

Claims 124, 129-131 and 135-138 are rejected under 35 U.S.C. §102(b) as being anticipated by clone H74302 isolated by Hillier *et al.* (1995).

The instant application claims **PRO809 nucleic acids**. Applicants had submitted that the Hillier EST clone does not disclose nor reduces to practice the full length sequence of SEQ ID NO: 222. To support this assertion, Applicants will shortly file a Declaration under 37 C.F.R. §1.131 by Dr. William Wood, co-inventor in this application, Head of the Bioinformatics Department at Genentech, Inc., under whose supervision the cluster analysis for the PRO809 nucleic acid was done in the nucleic acid and protein databases.

Briefly, Applicants submit that, Hillier does not disclose that their EST was part of a full length cDNA sequence that coded for a polypeptide (based on the alignment submitted as Item 13 of the Evidence Appendix with the Appeal Brief). The EST only codes for a truncated version of SEQ ID NO: 222. Thus, Hillier *et al.* did not teach nor reduce to practice the instantly claimed nucleic acid sequence. Further, one of skill in the art would not have been able to envision the cDNA clone defined in SEQ ID NO: 222 from the teachings of Hillier alone because the Hillier sequence lacks the C-terminus of the cDNA and therefore, Hillier *et al.* does not anticipate the instant invention.

Accordingly, the cited reference, Hillier *et al.*, does not teach or anticipate the instant invention and thus, this rejection under 35 U.S.C. §102(b) should be withdrawn.

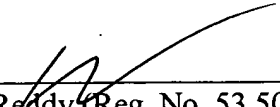
The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. **08-1641** (referencing Attorney's Docket No. **39780-2730 P1C55**).

Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: July 5, 2006

By:  (Panpan Gao  
43.626)  
Daphne Reddy (Reg. No. 53,507)

*on behalf of Daphne Reddy*

**HELLER EHRMAN LLP**  
275 Middlefield Road  
Menlo Park, California 94025  
Telephone: (650) 324-7000  
Facsimile: (650) 324-0638

SV 2217845 v1  
7/1/06 4:31 PM (39780.2730)